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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. [redacted] 118

ERNST JOHAN JENS HENRIKSEN and W. A. SHEAFFER PEN COMPANY, *Petitioners*

v.

CORY CORPORATION, *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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v.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Ernst Johan Jens Henriksen and W. A. Sheaffer Pen Company, Petitioners above named, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above-entitled case.

CITATIONS TO OPINIONS BELOW

The opinion of the Court of Appeals, dated January 20, 1964, is printed in the Appendix hereto, *infra*, p. 1a, and is reported at 327 F. 2d 409. The District Court filed no opinion. The findings of fact and conclusions of law entered by the District Court appear in the Record at pages 405-20.

JURISDICTION

The judgment of the Court of Appeals was initially entered on January 20, 1964 (App. 9a), and became final on February 26, 1964, upon denial (App. 24a) of a timely filed Petition for Rehearing (App. 10a, 20a). The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. Is Patent Office Rule 41 of 1948, providing for a procedural "election of species" in the course of Patent Office applications, constitutional as interpreted by the Court of Appeals below?

2. Where an inventor and the officials of the Patent Office, during the course of an application for a patent, have specifically agreed in writing and of record upon the meaning of certain technical descriptive words of art in the application, has any court the power and competence to declare that the technical descriptive words of art do not have the meaning so agreed upon?

3. Where a Patent Office Examiner, at an early stage of a patent application, requires an applicant to make a provisional, contingent, procedural "election of species" between several different claims under Patent Office Rule 41, which demand the applicant must obey and which is then non-reviewable, may a court

constitutionally interpret such a procedural election of species as a voluntary and unconditional substantive "abandonment" by the applicant of a significant portion of his invention without

(a) considering the entire subsequent history of the application in the Patent Office?

(b) considering whether the contingency, explicitly stated in the election, was satisfied?

(c) considering whether the election was subsequently modified, withdrawn or nullified with the consent of the Examiner?

(d) considering the language and substance of the specification and claims ultimately approved and allowed by the Patent Office?

PATENT OFFICE RULE AND COMMISSIONER'S ORDER INVOLVED

The pertinent provisions of the rules and regulations here involved are Patent Office Rule 41 as it read in 1948 and Patent Commissioner's Order No. 3527 (Official Gazette of the United States Patent Office, Vol. 520, November 12, 1940, page 259) which read as follows:

> "41. Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application: *Provided,* That more than one species of an invention, not to exceed three, may be claimed in one application if that application also includes an allowable claim generic to all the claimed species. In the first action on an application containing a generic claim or claims and claims to more than

one species thereunder the examiner, if he is of the opinion after a complete search that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable."

Order No. 3527 "Where an application is filed with claims specific to each of two or more species and a claim or claims generic thereto, the Examiner, in the first action, will give a complete action on the merits of all generic claims, and if no generic claim is found allowable, require election of one species; or if any generic claim is found allowable and the number of species claimed exceeds three, a requirement for election of three species will be made. If, however, the number of species claimed does not exceed three, a full action on the merits of such species claims will also be given where a generic claim is found allowable.

"Where election of species is required, the applicant's response to be complete must include an amendatory action or traverse relating to the rejected generic claims, and an election of species conformably to the Examiner's requirement."

STATEMENT OF THE CASE*

On May 18, 1954, petitioner Henriksen was granted patent No. 2,678,634 (Rec. 299-302) on a novel construction for a ball point pen. Petitioner Sheaffer acquired an exclusive license under this patent including the exclusive right to sublicense others (Rec. 406).

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* All references to the Appendix printed *infra* are indicated by "App". All references to the Printed Record in the Seventh Circuit Court of Appeals are indicated by "Rec".

The invention permitted, for the first time, the simple construction of ball point pens having an ink reservoir of wide diameter and therefore containing a large quantity of ink. Previously the only simple, inexpensive and efficient construction was to use a narrow ink reservoir in which capillary attraction between the ink and the sides of the barrel formed a meniscus which prevented the ink from running out of the barrel when the pen was inverted. Several others had invented complicated and inefficient devices for use with wide diameter reservoirs, none of which proved fully satisfactory in commercial use.

The Henriksen invention is deceptively simple. He provides a "follower" to be placed on top of the ink column in a large diameter reservoir. This follower follows the ink downwardly in the reservoir as the ink flows out when the pen is used, prevents air from contacting the ink or from mixing with the ink, and serves as a complete barrier to the reverse flow of ink out of the reservoir if the pen is inverted. The key to the invention resides in the nature of the follower. As stated in the patent specification, this follower can be a semi-pasty mass of a composition of paraffin (as a fatty substance or derivative of petroleum and other mineral oils) or of wax or of a viscous pulpy mass (Rec. 301). It has the properties of not mixing with the ink and of readily conforming to the side walls of the reservoir (Rec. 301). The patent claims define the follower as a viscous pulpy mass or a flow-resistant pulpy mass (Rec. 302).

The respondent openly copied the Henriksen invention, using as the follower a product known as "Texas Star-O grease" (Rec. 414) which has all of the prop-

erties and characteristics of the follower described and claimed in the Henriksen patent (Rec. 415-16). Petitioners sued for infringement. Jurisdiction of the District Court was founded on 35 U.S.C. 281.

The District Court held the Henriksen patent valid (Rec. 420). The District Court specifically found from trial testimony and documentary evidence that "Texas Star-O grease" was a viscous pulpy mass and a semi-pasty mass of a composition of paraffin (Rec. 416) and that the respondent had infringed the patent (Rec. 420). The Court of Appeals affirmed the validity of the patent (App. 3a). However, the Court of Appeals adjudicated that the respondent had not infringed the patent for the sole reason that Henriksen had unconditionally disclaimed and "abandoned a 'greasy' follower" from the scope of his claims during the administrative proceedings in the Patent Office (App. 3a to 7a). Therefore, the Court of Appeals ruled there was a file wrapper estoppel against the petitioners with respect to a "greasy" follower, including greasy materials which were also viscous pulpy masses (App. 7a).

This decision, if allowed to stand, severely limits the Henriksen patent far beyond the area encompassed by the prior art (Rec. 416-18) or any argument made by Henriksen before the Patent Office to obtain his patent. It advises the industry that the patent can be avoided by the simple device of using a grease for the follower, even though a grease such as Texas Star-O is a viscous pulpy mass or flow-resistant pulpy mass. The Court of Appeals reached this result by the development of a novel and previously unknown extension of the doctrine of file wrapper estoppel, allegedly based upon Patent Office Rule 41 and Patent

Office order 3527, as they existed in the years 1946 to 1948[1]

The proceedings in the Patent Office leading up to the issuance of the Henriksen patent were as follows: The specification of the initial application (Rec. 168-80) filed by Henriksen on October 26, 1946, described the composition of the follower variously as "a body of light metal or a solid or semi-pasty body of a composition of paraffin" or "a viscous or pulpy mass" (Rec. 173). The several original claims presented in the application (Rec. 180-87) recited the follower generically (e.g. claim 9) and defined it variously as light metal (claim 15), resilient material (claim 16),

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[1] Rule 41 finds its counterpart in new Patent Office Rules 141 and 146 which are in effect today. All of the points argued hereafter in this petition are equally applicable to these renumbered rules which read as follows:

> "**141. Different inventions in one application.** Two or more independent and distinct inventions may not be claimed in one application, except that more than one species of an invention, not to exceed five, may be specifically claimed in different claims in one application, provided the application also includes an allowable claim generic to all the claim species and all the claims to each species in excess of one are written in dependent form (rule 75) or otherwise include all the limitations of the generic claim."

> "**146. Election of species.** In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the examiner, if of the opinion after a complete search on the generic claims that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable. However, if such application contains claims directed to more than five species, the examiner may require restriction of the claims to not more than five species before taking any further action in the case."

solid paraffin (claim 17), wax (claim 18) and pulpy mass (claim 19).

By letter of June 15, 1948 (Rec. 194-95), the Patent Office Examiner rejected all of the generic claims then pending in the application and, *inter alia,* required Henriksen to make an election of species under Patent Office Rule 41 and Commissioner's Order No. 3527. These *required* Henriksen to designate one of the species of followers noted by the Examiner for further consideration by him in the event that a claim which defined the follower generically (e.g. claim 9) was not later considered allowable. The election, however, was to be provisional and contingent, i.e. it was to constitute a final election of species *only* if no generic claim was *ultimately* allowed. It was purely procedural in nature. ***Under the rules Henriksen was compelled to make the election at this time and the demand by the Examiner was non-reviewable.***

In response to the Examiner's non-reviewable demand, Henriksen by amendment filed December 15, 1948, added three new claims, 28, 29 and 30 (Rec. 196-97), in which he variously defined the follower as a viscous mass, a greasy substance and a pulpy mass. He stated (Rec. 198) that claim 28 (viscous) represented the elected species but volunteered the comment that claim 29 (greasy) and claim 30 (pulpy) were directed to species to which elected claim 28 was generic. He then stated voluntarily and not pursuant to any requirement (Rec. 198):

> "Applicant further elects as a single species for the lid [i.e., follower] a lid of pulpy mass *in the event* that no generic claim should be found allowable." [2]

[2] Emphasis added in quoted material unless otherwise noted.

The Examiner had never demanded of Henriksen an election between claims 28, 29 and 30 because they did not become a part of the application until after the demand for election of June 15, 1948.

No final, definitive, unconditional election of anything was required at this time by the Examiner or made by Henriksen. Instead, in a letter dated May 2, 1949 (Rec. 199-200), the Examiner rejected everything. All claims specifying a follower (including the new claims 28, 29 and 30) were rejected on the ground of lack of invention over the prior art.

Henriksen tried again to convince the Examiner. On October 26, 1949, he reduced the number of his claims from thirty to five. In claim 9 he defined the follower generically as "non-solid" (Rec. 182) and in the other specific claims then in the case the follower was described variously as "a pulpy mass" (Rec. 184), "a viscous mass" and "a greasy substance" (Rec. 196-97).

On November 1, 1950 (Rec. 205-206), the Examiner again rejected everything as unpatentable over the prior art, namely, a newly cited Martin patent No. 2,495,013 (Rec. 319-22). In this rejection the Examiner referred in passing to the election of species for the follower. Since he determined to reject everything he made no definitive ruling on the description of the follower.

By amendment filed on April 28, 1951 (Rec. 207-209), Henriksen made one more effort. He withdrew all pending claims and started over with a single new claim 31 which described the follower as "a substantially viscous pulpy mass." This new claim was urged to distinguish over the prior Martin patent on the

grounds that Henriksen's follower was other than ink and that Henriksen's reservoir had a wide diameter. This new claim was also rejected by the Examiner as unpatentable over Martin and this rejection was final (Rec. 210). Henriksen at this juncture took two contemporaneous actions. He filed an appeal to the Board of Appeals from the Examiner's rejection. He also filed a new claim 32 (Rec. 212) which the Examiner rejected (Rec. 225). The relevancy of the Martin patent to the Henriksen claims was the only point at issue before the Board of Appeals (Rec. 216-33).

The Board of Appeals reversed the Examiner (Rec. 233). After this decision the Examiner allowed both claims 31 and 32 of the Henriksen application but *required that the drawings and specification be limited to subject matter embraced within the scope of the claims as allowed* (Rec. 234-35). Henriksen thereupon submitted a substitute description of his invention (Rec. 236-40) in which the composition of the "follower" encompassed by the allowed claims was described as follows (Rec. 237-38, 301):

> "a semi-pasty mass of a composition of paraffin (as a fatty substance or derivative of petroleum and other mineral oils), or of wax, or of a viscous pulpy mass other than said ink . . ."

This description is specifically definitive of respondent's Texas Star-O grease (Rec. 416).

Further, Henriksen in an amendment filed March 4, 1954 (Rec. 248-50) and entered with the specific written approval of the Examiner and the Supervisory Examiner, added an additional claim which defined the follower as a "flow resistant pulpy mass" and specifically

illustrated the compositions of the follower included within the scope of the allowed claims in this language (Rec. 249):

> "One of such followers for example could consist of cup-grease or a mineral oil composition thickened by a mineral soap."

It was conceded by the respondent in the trial court that respondent's Texas Star-O grease is an identical material.[3]

As mentioned above, the Court of Appeals found a "file wrapper estoppel" here by its holding that the provisional, contingent, non-reviewable election of species by Henriksen on December 15, 1948, was in law a final, definitive, unconditional withdrawal and abandonment, for all future time, of a substantial part of his invention.

The Court of Appeals gave no effect to the six-year subsequent history of the application in the Patent Office, or to the subsequent acts of Henriksen, or to the subsequent acts and agreements of the Examiner and the Supervisory Examiner, or to the reversal by the Board of Appeals, or to the agreements with the Patent Office as to the meanings of words of art used in the patent claims, or to the ultimate final action of the Patent Office on Henriksen's invention.

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[3] In respondent's Trial Brief it was stated (page 129): "... the grease component of defendant's accused ball point pens is Texaco Star "O" grease [e.g. Texas Star-O grease]. Such a grease is a composition made up of mineral oil and about 6.6% of a calcium soap. ... The calcium soap is ... a mineral composition." See also respondent's answer to interrogatory No. 24 J III (PX-108).

REASONS FOR GRANTING THE WRIT

A. This case raises questions of national and far-reaching importance in the administration of the patent laws of the United States which have not heretofore been passed upon by this Court.

B. This case involves a principle which, if the decision of the Court of Appeals is allowed to stand, will cast a cloud upon the validity and scope of thousands of presently existing patents.

C. This case involves a new concept of file wrapper estoppel, stated for the first time by the Court of Appeals below, which is inconsistent with all previous decisions of this Court and of all other Courts of Appeal.

D. This case involves a direct conflict between the Seventh and Ninth Circuits, in the only two cases known to counsel for petitioners which have dealt specifically with the meaning and effect of a provisional, contingent, non-reviewable "election of species" in relation to the applicability of the doctrine of file wrapper estoppel. The two decisions are almost contemporaneous. The earlier Ninth Circuit decision (*Engelhard Industries, Inc.* v. *Research Instrument Corp.*, 324 F. 2d 347) is dated October 28, 1963. The diametrically opposed decision by the Court of Appeals in the present case is dated January 20, 1964.

E. This case involves substantial questions of due process of law and the taking of the property of the petitioners without a "day in court."

F. This case involves the fundamental question of the power of the Federal Courts to overrule the spe-

cific written agreement between the Patent Office and an applicant as to the meaning of technical words of art used in the patent application, and the power of the courts to place their own interpretation on these technical words of art, in direct contradiction of the Patent Office agreement.

* * * *

1. The first essential question presented by this petition is whether the Court of Appeals, within the bounds of due process, can limit the effective scope of the Henriksen patent by a ruling that a provisional, contingent and procedural election of species by Henriksen during the very early stages of the application in 1948 was in law a final, definitive, unconditional withdrawal and abandonment by Henriksen of a significant part of his invention and therefore a proper basis for the application of a file wrapper estoppel; and by further ruling that this act in 1948 was to be interpreted in a vacuum, without taking into account the entire history of the subsequent six years of proceedings in the Patent Office, up to the allowance of the patent in 1954.

2. The doctrine of "file wrapper estoppel" is well recognized. If an applicant for a patent, in order to overcome substantive objections on the part of the Examiner, voluntarily and *unconditionally* abandons a part of his claim in order to secure a grant of a patent on the remainder, this voluntary and unconditional abandonment will be binding upon him. The patentee in such a case cannot, after the patent is granted, claim that the language finally allowed in the patent may be broad enough to include, by indirection, that which he unconditionally abandoned in order to get

the patent allowed. There are literally hundreds of cases which have been decided by the District Courts, the Courts of Appeal and this Court in the application of this doctrine. See by way of illustration, *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126 (1942) and cases cited at pages 136-37; *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940); *Waring Products Corp.* v. *Landers, Frary & Clark*, 263 F. 2d 160, 164-65 (2 Cir. 1959); *Berry Brothers Corp.* v. *Sigmon*, 317 F. 2d 700, 705 (4 Cir. 1963); *Edward Valves, Inc.* v. *Cameron Iron Works, Inc.*, 286 F. 2d 933, 943 (5 Cir. 1961); *L. S. Donaldson Co.* v. *LaMaur, Inc.*, 299 F. 2d 412, 420 (8 Cir. 1962); *Research Products Co.* v. *Tretolite*, 106 F. 2d 530, 535-36 (9 Cir. 1939); *Sears, Roebuck & Co.* v. *Jones*, 308 F. 2d 705, 708 (10 Cir. 1962); *Straussler* v. *United States*, 154 Ct. Cl. 276, 290 F. 2d 827, 830-31 (1961); cases cited in 69 C.J.S. 720 to 726, § 212, notes 30 to 59.

However, until the decision below, no court has ever predicated a file wrapper estoppel exclusively upon a provisional, contingent, *conditional* election of species made by an applicant during the course of the proceedings in the Patent Office without regard to the full subsequent history of the patent application.

3. An election of species has nothing to do with the substantive merit of an invention. It is purely procedural preliminary matter for the administrative convenience of the Patent Office examiners and is related to the doctrine of "misjoinder" of inventions. See Patent Office Rule 41 (*supra*, pages 3-4); Wolcott's *Manual of Patent Office Practice* (9th Ed. 1946) at pages 105, 107; and present Patent Office Rules 141 and 146 quoted (*supra*, page 7n). It is in some respects parallel to Rule 18, F.R.C.P., 28 U.S.C., re-

lating to the joinder of alternate claims in a civil action.

To use the technical language of the patent law, under old Patent Office Rule 41 and new Patent Office Rules 141 and 146, if an inventor is allowed a generic claim, he may then join with it several species claims which are within the scope of the generic claim; but if no generic claim is allowed, or allowable, the Examiner may interpret the several species claims as separate inventions and may procedurally require the applicant to file separate applications for each. In other words, if no generic claim is allowed, or allowable, the joinder of the several species claims is procedurally, not substantively, improper, and an assertion by the Examiner of procedural misjoinder of claims is appropriate.

Accordingly, the Patent Office practice in 1948 under Rule 41 (the critical time here) permitted an Examiner, at an appropriate stage of the proceeding, to require an applicant to make an election of species where the application for the patent contained claims which, in the opinion of the Examiner, constituted several species and which might conceivably be misjoined. However, such an "election" could never be final nor conclusive because, by definition, there would be *no* misjoinder if a generic claim was ultimately allowed.

Further, since the Examiner's requirement of an election was specifically made contingent and conditional, and since it could have no binding or permanent effect on the inventor until a later stage of the proceedings, the Patent Office practice specifically provided that the Examiner's requirement was to be nonreviewable. Patent Office Supervisory Examiner's

Memorandum of July 16, 1943,[4] *Wolcott's Manual of Patent Office Procedure* (9th Ed. 1946) at page 111.[5] It must be recalled that the election could become final and binding only if, at some later date, there was a "final" action on the application and if no generic claim was ultimately allowed. For this reason, the absence of any right of review at the time when the election was demanded could not raise any constitutional question if the election was initially given no binding or conclusive effect.

However, if at the end of the application process the Patent Office by a "final" action denied any generic claim, then an election previously made and still in effect could validly be considered as definitive, final and unconditional. It would then be reviewable. McCrady, *Patent Office Practice* (3rd Ed. 1950) page 282. To the contrary, if at the end of the application process the Patent Office granted a generic claim, this implied that no valid basis for any election had ever existed and no demand could ever validly be made upon the applicant for a definitive, final, unconditional election between his various species claims. This follows because all his species claims would be properly joined procedurally in a single application, bottomed upon the allowance of the generic claim.

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[4] "The species relationship is a question of fact, unaffected by the presence or absence of a generic claim, and the *Examiner's ruling thereon is, under Notice of October 29, 1940, not subject to review by the Classification Examiner.*" Quoted in Wolcott's *Manual of Patent Office Procedure* (9th Ed. 1946) at page 112.

[5] "Since the above procedure concerns solely election of species under Rule 41, . . . the requirement for election of species is *not subject to review by the Classification Examiner,* nor is any action subsequent thereto dependent upon approval of such requirement."

In the light of this, the applicant's initial election was always stated in contingent and conditional form, e.g. "If no generic claim is ultimately granted to me, and if I am therefore obliged hereafter to choose between species 'A' and species 'B', I will choose species 'A'."

Accordingly, the ultimate effect of a provisional conditional election, made at an early stage, can never be determined without an examination of the entire record of the application, i.e., to determine if, and to what extent, the conditional election had been modified, or had been withdrawn,[6] or had become a nullity, or had become unconditional and binding by reason of the subsequent history of the application. Clearly, the meaning and the effect of a preliminary conditional election can never be determined until the entire Patent Office record is complete and until the ultimate disposition of the application can be studied. (See discussion of *Engelhard Industries, Inc.* v. *Research Instrument Corporation, infra*, pp. 21-23.)

4. The Court of Appeals below adopted an antithetical approach. It refused to consider the full record in the Patent Office. It refused to consider the full history of the application after the 1948 election. It refused to consider whether the contingency expressed in the election had occurred; whether the election had been withdrawn or amended or nullified; or whether a generic claim had in fact ultimately been allowed. It treated the initial contingent election as though it were final and unconditional and substantively binding upon Henriksen for all purposes.

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[6] In its opinion in *Engelhard* (*infra*, p. 22) at 324 F. 2d 350, the Ninth Circuit Court recognized the right of an applicant to withdraw his election of species by his subsequent conduct.

In fact, the history of the patent shows that the 1948 election was in effect wholly withdrawn at a later stage with the consent of the Examiner when new terminology in the form of new claim 31 was adopted to define Henriksen's true invention (Rec. 207-209); the definition of the composition of the follower as stated in that claim was fixed in the record by written agreement between Henriksen and the Patent Office (Rec. 249-50). Everything in the record negates the existence of any definitive and unconditional election in 1948 to abandon a claim to the composition admittedly employed by the respondent. Yet the Court of Appeals ignored the governing facts in the record after 1948 and found, on its own, a file wrapper estoppel by reading the 1948 election in a vacuum as though it were from its inception intended by the applicant to be, and accepted by the Examiner, as final, irrevocable and substantively definitive.

5. The record further shows that the Examiner here never enforced the provisional contingent election. He twice rejected both the generic follower claims and the species follower claims 28, 29 and 30 after the election had been made (Rec. 199-200, 205-206). The Examiner did *not* reject the generic claims *only* and rule favorably on one of the species claims. If the Examiner had done this and if the applicant had acquiesced in this, a file wrapper estoppel would properly have been imposed.

It is the acquiescence which is the key to the question. There can be no estoppel without a definitive, unconditional action and an acquiescence. *Leggett* v. *Avery*, 101 U.S. 256, 259 (1879); *Morgan Envelope Co.* v. *Albany Perforated Wrapping Paper Co.*, 152

U.S. 425, 429 (1894); *L. S. Donaldson Co.* v. *LaMaur, Inc.*, 299 F. 2d 412, 420 (8 Cir. 1962).

Yet in this case, no acquiescence can be found. As we have noted, the Examiner never enforced the 1948 election. He threw out the entire invention. He then permitted the applicant in 1951 to withdraw all his then follower claims, both generic and specific, and to file an entirely new follower claim 31 (Rec. 207-209). He then rejected this new single claim as unpatentable over the prior art.

Then, after everything had been rejected, the applicant appealed on the merits and the Board of Appeals reversed. Thereupon the Examiner granted the new claims, exactly as demanded by Henriksen in 1952, four years after the 1948 election (Rec. 234). He went even further. He required Henriksen to limit the disclosure in his patent specification to the exact technical definition of a composition of the follower that was included within the scope of his allowed claims (Rec. 234-35).

Henriksen complied with this requirement and defined the claimed follower *inter alia* as a semi-pasty mass of a composition of paraffin such as a fatty substance or derivative of petroleum and other mineral oils (Rec. 237-38). The Examiner accepted this definition and gave it his approval. This definition encompasses Texas Star-O grease used by the respondent. (Rec. 76).

At a later meeting the Examiner accepted and agreed to an even more specific illustration of the accepted definition of the viscous or flow-resistant pulpy composition of the follower as stated in the claims. One

such illustration, accepted and approved in writing by the Examiner and by the Supervisory Examiner, was "a mineral oil composition thickened by a mineral soap" (Rec. 249). It is conceded that this phrase exactly defines Texas Star-O grease used by the respondent. See footnote 3, page 11, *supra*. Yet this is the very definition which the Court of Appeals said was excluded from the patent grant.

6. In ignoring the record in the Patent Office after 1948, the Court of Appeals departed from the historic theory of the contract nature of the grant of a patent in direct conflict with the other circuits. It did not consider the record as a series of negotiations, freely entered into between the applicant and the Patent Office, to be interpreted in accordance with the general laws of contract negotiations. *Doble Engineering Co.* v. *Leeds & Northrup Co.*, 134 F. 2d 78, 84 (1 Cir. 1943); *Hookless Fastener Co.* v. *G. E. Prentice Mfg. Co.*, 68 F. 2d 848, 851 (2 Cir. 1934); *Strong-Scott Mfg. Co.* v. *Weller*, 112 F. 2d 389, 394 (8 Cir. 1940); *Del Francia* v. *Stanthony Corp.*, 278 F. 2d 745, 747 (9 Cir. 1960); *Tschappat* v. *Hinderliter Tool Co.*, 98 F. 2d 994, 998 (10 Cir. 1938).

The Court of Appeals departed from the historic theory of the importance of the intention of the parties in the interpretation of a patent, in direct conflict with the other circuits. *Doble Engineering Co.* v. *Leeds & Northrup Co.*, 134 F. 2d 78, 83-84 (1 Cir. 1943); *Lincoln Stores* v. *Nashua Mfg. Co.*, 157 F. 2d 154, 158 (1 Cir. 1946); *Zenith Radio Corp.* v. *Lehman*, 217 F. 2d 954 (2 Cir. 1955) affirming opinion in 121 F. Supp. 69, 73 (SD NY 1954); *Strong-Scott Mfg. Co.* v. *Weller*, 112 F. 2d 389, 394 (8 Cir. 1940), *Del Francia* v. *Stanthony Corp.*, 278 F. 2d 745, 747 (9th Cir. 1960); *Di-*

rectoplate Corp. v. *Donaldson Lithographing Co.*, 51 F. 2d 199, 202 (6 Cir. 1931); *Tschappat* v. *Hinderliter Tool Co.*, 98 F. 2d 994, 998 (10 Cir. 1938).

The Court of Appeals ignored the principle laid down by this Court in *I.T.S. Rubber Co.* v. *Essex Rubber Co.*, 272 U.S. 429, 442 (1926) that claims must be given

> "the meaning which was intended by the applicant and understood by the examiner."

It reached the absurd conclusion that a statement in writing by an applicant that his technical words of art specifically included "a mineral oil composition thickened by a mineral soap" (Rec. 249), which statement was officially accepted by the Patent Office, will be held, as a matter of law, to mean that the applicant had definitively and unconditionally abandoned and surrendered all claim to "a mineral oil composition thickened by a mineral soap."

The Court of Appeals ignored the general principle that the applicant for a patent may be his own lexicographer and may invent his own words of art to define the scope of his invention. Here the decision of the Court below is again in conflict with the other circuits. *Georgia-Pacific Corp.* v. *U. S. Plywood Corp.*, 258 F. 2d 124, 136 (2 Cir. 1958);[7] *Electric Storage Battery Co.* v. *Shimadzu*, 123 F. 2d 890, 897 (3 Cir. 1941); *Bianchi* v. *Barili*, 168 F. 2d 793, 799 (9 Cir. 1948).

But most important of all, in refusing to examine or consider the full subsequent history of the patent application in the Patent Office after the 1948 election,

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[7] The court refers to "the meager tools provided by language, tools which admittedly lack exactitude and precision."

the Court of Appeals below is in direct conflict with the principles stated in the very recent decision of the Ninth Circuit in *Engelhard Industries, Inc.* v. *Research Instrument Corp.*, 324 F. 2d 347 (1963), decided October 28, 1963, certiorari denied May 4, 1964. *Engelhard* and the present case are strikingly similar. Both are file wrapper estoppel cases. In each case a provisional election of species was required. In each case, the primary question was the definition of the composition of an essential item in the invention. In each case, *after* the election, the applicant withdraw all his claims and substituted new claims with an amended definition of the composition of the item in question. In *Engelhard* the Examiner did nothing affirmative; he merely failed to object to the new definition. In the present case, the Examiner affirmatively approved the new definition in writing and emphasized this by requesting and then approving in writing specific illustrations of the meaning of the definition.

In *Engelhard* the District Court had found a file wrapper estoppel (324 F. 2d 349). The Court of Appeals found otherwise, properly interpreting the effect of the conditional election of species by an analysis of the subsequent withdrawal of claims, the substitution of new wording for the critical definition and the meaning of the new wording by an examination of the entire subsequent Patent Office record and the subsequent actions of the Examiner. The present case is the exact opposite. Here the District Court did not find a file wrapper estoppel. The Court of Appeals reversed, treating the conditional election of species as absolute and refusing to analyze the subsequent withdrawal of claims, the substitution of new wording for the definition of the invention and the meaning of

the new wording by an examination of the entire subsequent Patent Office record and the subsequent actions of the Examiner. The conflict could not be more irreconcilable.

7. The Court of Appeals decided this case in direct violation of Patent Office Rule 41, the rule under which Henriksen made his election. That rule provides that the applicant need make only a conditional election, i.e.,

> "to elect that species of his invention to which his claims shall be restricted *if no generic claim is finally held allowable.*"

Yet the Court of Appeals held here that the claims will be restricted under the election without regard to whether a generic claim was ultimately allowed and without regard to whether the election was later amended or withdrawn with the consent of the Patent Office. Neither this Court nor any other Court of Appeals nor Neither this Court nor any other Court of Appeals nor District Court has ever laid down such a rule before. This Court has never before passed upon this important question.

8. The case raises another basic question, namely: Who is to determine what the Patent Office intended by the use of technical words of art in the grant of a patent and what are the limits of the powers of the courts to interpret the meaning of those technical words of art? Obviously, if the record in the Patent Office is ambiguous, and if the meaning of the technical words of art is not clear, that is, if there is no clear "legislative history," then the courts have no choice except to assume the burden of resolving the ambiguities in the Patent Office record.

But if there is no ambiguity in the Patent Office record, and if the very question of the meaning of the technical words of art, as presented to the Court, has been presented *in ipsissimis verbis* to the Patent Office and answered by it definitively and unconditionally, then what power has any court to overrule the expressed agreement between the applicant and the Patent Office as to their meaning?

Counsel for the petitioners have found no direct authority on the point in any decided case. They have found two *dicta,* in the Second and Third Circuits, which are illustrative and helpful. The first *dictum* is in *Westinghouse Electric Corp.* v. *Hanovia Chemical & Mfg. Co.,* 179 F. 2d 293, 296-97 (3 Cir. 1949), in which the court said:

> "The claims of a patent must always be explained by and read in connection with the specification and *in the light of definitions* and admissions made by the applicant in the proceedings in the Patent Office."

This record perfectly illustrates the principle of the *Westinghouse* case. The applicant and the Patent Office officials agreed in 1953 that a viscous pulpy mass included a mineral oil (greasy) composition (Rec. 238). They further agreed in writing in March, 1954 (Rec. 249), that the definition of the composition of the follower as recited in the patent claims should include, *inter alia,* "a mineral oil composition thickened by a mineral soap" (i.e., a grease). Has the Court of Appeals the power to decide that the definition finally approved by the Patent Office does *not* include this material? And if so, where does that power arise?

In the other *dictum* Judge Learned Hand considered this matter and expressed it even more dramatic-

ally in his opinion in *Dwight & Lloyd Sintering Co.* v. *Greenawalt*, 27 F. 2d 823, 832 (2 Cir. 1928). In his discussion of the file wrapper history to determine the meaning of the terms used, he said:

> "After the claims have received an interpretation on which alone they secured any allowance at all, *we conceive ourselves bound by the meaning so put upon them. Anything else makes an absurdity of the proceeding itself.*" (emphasis supplied)

Can file wrapper estoppel extend to deny the Examiner the right to decide what he is granting? It is the Examiner, not the court, who determines the scope of the grant. If the Examiner advised the applicant that he is granting him a patent for a certain designated invention, with a clearly defined definition of technical terms, can the court decide that the Examiner unconditionally required the applicant to abandon the very invention and the very definition which the Examiner specifically told the applicant he was granting him? As Judge Hand said, such a doctrine truly leads to an absurdity.

9. The effect of the decision below goes far beyond the confines of this one patent and this one infringement.

There are thousands of patents outstanding today in which at some stage the inventor had been asked to make a contingent preliminary election of species. Before the decision below, no court has ever suggested that every such election, no matter how conditionally it is stated, is in fact unconditional and acts as a substantive restriction on the invention *without regard to what happened thereafter in the Patent Office.* It has always been assumed that the effect of such a con-

ditional election depends entirely upon the future history of the patent application, upon the future actions of the inventor, the future actions of the Examiner and the ultimate fate of the application itself. (See *Engelhard, supra,* p. 22, which sets forth this latter rule.)

This conflict is so important to the patent laws that review by this Court is now appropriate. If the decision below remains unreviewed, it will be the leading case for the Seventh Circuit, the center of the huge industrial Middle-Western complex and a powerful factor in patent litigation. Every existing patent, in the course of which an election of species has been made, will now become vulnerable in that Circuit to substantive annulment by imposing the rule that a conditional election is in fact unconditional and that, *irrespective of the future history of the application,* the inventor will be held to have abandoned unconditionally a significant part of his invention. If this decision is not reviewed by this Court, and if the conflict with *Engelhard* remains unresolved, other Courts of Appeal will have the choice to adopt either of the diametrically opposed doctrines of the decision below and of *Engelhard,* with chaotic results to the meaning and scope of thousands of United States patents.

Further, this decision strikes at the heart of the patent system. It takes away from the Examiner and the Patent Office officials the control of patent applications and the power to agree, during the administrative process, upon the meaning of the technical words of art in a patent. It permits the court to decide that where the Patent Office specifically says that the technical language of the patent is granted to include items of the color "red," the court may rule that

the patent never was intended to cover "red" items and that anyone may practice "red" without infringement.

The decision also raises fundamental constitutional questions.

10. The grant of a patent is the creation of a valuable property right through action of the Patent Office under authority of the Congress and founded upon Article I, Section 8, Clause 8 of the Constitution. Like all other property rights, including all contracts of the United States, it is protected by the Fifth Amendment from confiscation without due process of law. *Seymour* v. *Osborne*, 78 U.S. 516, 533 (1870); *Cammeyer* v. *Newton*, 94 U.S. 225, 226 (1876); *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U.S. 405, 425 (1908); *Lynch* v. *United States*, 292 U.S. 571, 579 (1934).

If Patent Office Rule 41, upon which the Court of Appeals relied (App. 5a, 6a), (its renumbered counterparts, new Rules 141 and 146 being in the same situation) is interpreted as the Court of Appeals has interpreted it, it is clearly unconstitutional on two independent grounds.

First, the rule provides for a contingent, provisional, conditional election of species, to be effective *only if* "no generic claim is finally held allowable." No notice is given in the rule that, under any circumstances, it can be a final, unconditional, binding abandonment of invention the moment it is made and without regard to the subsequent history of the generic claims and of the application in the Patent Office. If finality is ascribed *ab initio* to the election, without warning or

notice that this result can follow, then the rule is fatally defective insofar as it may result in the confiscation of property rights without notice.

Second, the Rule is unconstitutional because no provision is made for any contemporaneous hearing at which the applicant may be heard on the issue of the validity of the Examiner's demand for an election which will result in a mandatory abandonment *ab initio* by the inventor of part of his invention. *Standard Oil Co.* v. *Missouri,* 224 U.S. 270, 281 (1912); *Interstate Commerce Commission* v. *Louisville and Nashville Railroad Co.,* 227 U.S. 88, 91 (1913).

Further, Rule 41 (and its renumbered counterparts new Rules 141 and 146) now will have become a trap, even for the wary. The situation is constitutionally similar to that of the vague and ambiguous criminal statute which gives no adequate notice of the nature of the alleged offense. Such statutes are unconstitutional. *United States* v. *Cohen Grocery Co.,* 255 U.S. 81, 89 (1921); *Lanzetta* v. *New Jersey,* 306 U.S. 451, 458 (1939); *Champlin Refining Co.* v. *Corporation Commission of Oklahoma,* 286 U.S. 210, 243 (1932); *Connally* v. *General Construction Company,* 269 U.S. 385, 394-95 (1926); *Wright* v. *Georgia,* 373 U.S. 284, 293 (1963).

Here Rule 41 unambiguously tells an applicant that if he obeys the order of the Examiner and makes an election of species, his election is only contingent and conditional. Yet the Court of Appeals has convicted him of having thereby made a noncontingent and unconditional abandonment of the substance of part of his invention, *ab initio,* without regard to what hap-

pened later on in the Patent Office and without regard to the terms and provisions of the patent ultimately granted to him. He is clearly entitled to invoke the constitutional principle that the Court of Appeals has taken his property from him without notice and without any opportunity for a "day in court."

The applicant has no right of appeal or review of an Examiner's demand for a procedural election of species until after "final" action on the application, McCrady, *Patent Office Practice* (3rd Ed. 1950) page 282. But suppose, as in the present case, the initial election is withdrawn or so modified, with the consent of the Examiner, that the applicant ultimately gets everything in his patent that he wishes. From what does he then appeal?

Clearly a right of appeal is required if the initial election remains unmodified and ultimately becomes final and binding on the applicant. Then, if he feels the Examiner has erred in requiring this limitation on his patent, he may have a review. But equally clearly, the applicant has nothing from which to appeal if the tentative conditional election disappears during the subsequent course of the proceedings in the Patent Office and the applicant ends up with everything that he desires.

Under the decision below, the applicant is hopelessly trapped. He has made a conditional election which is initially non-reviewable. Then the election is later withdrawn, or amended, or otherwise disappears from the record with the consent of the Patent Office officials. The applicant then receives the full grant that he seeks. Nothing remains from which he may

appeal. And now the courts declare that his ultimate patent grant is limited by that initial non-reviewable conditional election which later disappeared from the proceedings.

Finally, this case raises the question of the power of the Federal Courts to destroy patents by arrogating to themselves the power to read technical words of art as used in a patent grant as they please, without considering the agreements and specifically expressed intentions of the applicant and the Patent Office as to the meaning to be ascribed to those words in the patent grant (see Judge Hand in *Dwight & Lloyd Sintering, supra,* p. 25).

CONCLUSION

Because of the urgent necessity of resolving the conflict between the decision below and *Engelhard*' (decided in two different circuits within less than ninety days of one another and both within the last six months'), because of the unconstitutional interpretation of the Patent Office rule by the Court below, because of the improper arrogation of power by the Court of Appeals to annul the written agreements of the Patent Office authorities, and because of the nationwide impact of the conflicting decisions on the entire

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' Missouri Pacific R.R. v. Elmore & Stahl, decided May 4, 1964.

field of patents, it is respectfully requested that a writ of certiorari be granted.

Respectfully submitted,

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